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10/000,219	12/04/2001	Masafumi Nishitani	Q67539	9175
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The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAFUMI NISHITANI
and MASAEI TSURUMAKI

Appeal 2008-4625
Application 10/000,219
Technology Center 1700

Oral Hearing Held: Tuesday, November 18, 2008

Before CHARLES F. WARREN, CATHERINE Q. TIMM, and
MICHAEL P. COLAIANNI, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

JOHN BYRD, ESQ.
Sughrue-265550
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

1 The above-entitled matter came on for hearing on Tuesday,
2 November 18, 2008, commencing at 12:21 p.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Suzie,
4 Notary Public.

5 MS. BOBO-ALLEN: Calendar No. 41, Appeal Number
6 2008-4625, Mr. Byrd.

7 JUDGE WARREN: Good afternoon, Mr. Byrd.

8 MR. BYRD: Good afternoon.

9 JUDGE WARREN: As you know sir, you have 20 minutes.
10 You may begin when you are ready.

11 MR. BYRD: May it please the Board, I am John Byrd, and I
12 am representing Bridgestone Sports Co. Ltd., in this application. The
13 application includes six independent claims and each of these claims
14 includes a product by process limitation. I'd like to discuss product by
15 process limitations, as well as (inaudible) today.

16 Referring to the first independent claim, Claim 1, if you look at
17 Figure 2, Claim 1 includes the golf club with a shaft, and then a metal head
18 attached to the shaft. This metal head comprises a body having an opening
19 in which a striking face member is disclosed. Referring to the product by
20 process limitations, a striking face member including a plurality of metal
21 pieces, and these pieces are first fixed together by laser welding, and also
22 press forming is performed on a variety of metal pieces that are fixed
23 together, to form a curved surface portion.

24 Each of the independent claims includes similar product by
25 process limitations. For example, Claim 7 recites plastic working instead of
26 press forming, but also recites the laser welding operation. So in the

1 rejection, the Examiner acknowledges that the features of laser welding and
2 press forming are missing from the prior art references. However, the
3 Examiner has endorsed these features, relying on the fact that they are
4 product by process limitations.

5 However, the operations or processes that are provided in the
6 claim do result in structural differences that must be considered by the
7 Examiner in accordance with MPEP section 2113, where the Examiner
8 should consider a reference or evidence. We, in the prosecution, we
9 provided a declaration describing some of the different structural differences
10 between pieces that are provided by laser welding and press forming, and
11 those of the prior art.

12 For example, on page three of this 132 declaration, there's a
13 description about gaps between the pieces in conventional welding, and also
14 how welding rods fill these gaps. In a piece that is provided by the process
15 operations of the claims, it would be distinguished from these structures and
16 would have different features.

17 Another part of the declaration on page five mentions that large
18 regions are weakened by conventional welding, which provides a brittle
19 face. So in addition on page seven of the declaration, the exposure welding
20 requires overlapping structures they would not have in the laser welding.

21 So by use of laser welding to prepare these plates together, the
22 structural -- the device is structurally different and has increased strength
23 versus the prior art, and this allows these welded pieces to be aligned
24 together as a press form member. So essentially the Examiner has not
25 provided any comments at all about our declaration, and why these structural
26 differences are there.

1 JUDGE WARREN: Anything else, counselor?
2 MR. BYRD: That's all, Your Honors.
3 JUDGE WARREN: Judge Timm?
4 JUDGE TIMM: No questions.
5 JUDGE COLAIANNI: No questions.
6 JUDGE WARREN: Thank you.
7 Whereupon, at approximately 12:30 p.m., the oral hearing was
8 adjourned.